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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/682,876

Applicant(s)

Duchow

Examiner

James W. Myhre

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 27, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, 14-21, and 24-66 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12, 14-21, and 24-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3622

DETAILED ACTION

Response to Amendment

1. The Request for Reconsideration and Declarations filed on May 27, 2003 under 37 CFR 1.131 have been considered and are sufficient to overcome the Awada et al (US2002/0065713) reference.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 3, 5/2, 5/3, 6/2, 6/3, 7/2, 7/3, 8/2, 8/3, 9/2, 9/3, 10/2, 10/3, 11/10/2, 11/10/3, 14, 15, 17/14, 17/15, 18/14, 18/15, 19/14, 19/15, 20/14, 20/15, 25/14, 25/15, 26/14, 26/15, 29/14, 29/15, 32, 33, 35, 37-46, 50, and 53-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (2002/0065713) in view of Stewart et al (6,259,405).

Art Unit: 3622

Claims 2, 3, 14, 15, 44, 45, 50, 53, and 54: Scroggie discloses a system and method for providing a purchase incentive to a buyer over a computer network, comprising:

- a. Accessing a product database (col 2, lines 11-19 and col 6, lines 12-15);
- b. Displaying a list of products to the buyer (col 2, lines 11-19 and col 6, lines 12-15);
- c. Receiving a product selection from the buyer (col 2, lines 11-19 and col 6, lines 12-15);
- d. Receiving and storing information about the buyer (col 1, lines 53-55 and col 6, lines 32-35 and 55-58);
- e. Accessing a reseller (retail store) database to select a reseller based on the product selection and the buyer information (col 9, line 66 - col 10, line 3); and
- f. Transmitting the reseller information and a discount to the buyer (col 2, lines 1-4), wherein the discount is selected from a discount database based on the selected product (col 9, lines 20-25).

While Scroggie discloses selecting a retailer based on the location of the retailer in relation to the buyer, it is not explicitly disclosed that the retailer is selected based on the product and buyer information (other than buyer location). However, Stewart discloses a similar system and method for providing purchase information to a buyer over a computer network, which further discloses selecting a retailer based on the product (i.e. hotel room, rental car, etc.) and on the buyer's location, preferences, and demographics (i.e. preferred hotel company, room type,

Art Unit: 3622

etc.)(col 22, lines 22-65). Stewart further discusses that the system attempts to locate a preferred retailer, but if one is not within an appropriate range (i.e. within walking distance if used in a shopping mall or airport), the system will select a similar retailer. For example, if Stewart receives a request from a buyer to find a restaurant offering a particular style of food (i.e. barbecue), the system will select an appropriate restaurant or if “not available in the immediate vicinity, the location service provider may suggest alternatives based on the known geographical location which most closely match the user’s preferences” (col 26, lines 2-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such information as the desired product and the buyer’s preferences when Scroggie selects the retailer. One would have been motivated to select the retailer based on the product and other buyer information in order to ensure that the selected retailer carries the desired product and to better meet the desires of the buyer by limiting the selection to the nearest preferred retailer.

Claim 56: Scroggie and Stewart disclose a system for providing a purchase incentive to a buyer over a computer network as in Claim 2 above. While Scroggie discloses determining the closest retailer to the buyer (within the geographic area of the buyer), it is not explicitly disclosed that the retailer has been assigned a predetermined area of coverage (i.e. has franchise rights) which includes the area in which the buyer is located. However, Stewart discloses that the buyer can enter a preferred retailer/chain store (e.g. Denny’s restaurant, Avis car rental, etc.). The system will attempt to locate the nearest Denny’s restaurant or Avis car rental facility, if one is located within a reasonable distance from the buyer’s location. Thus, the system is searching for

Art Unit: 3622

the closest franchise to the buyer's location. It is inherent that a franchise has an assigned territory, as per the definition in Webster's II New Riverside University Dictionary, page 503, "franchise. 2. Authorization granted by a manufacturer to a distributor or dealer to sell its products. 3. The territory or limits within which a privilege, right, or immunity may be exercised". Thus, since Stewart allows the buyer to designate a preferred franchise (chain store), it would have been obvious to one having ordinary skill in the art at the time the invention was made that the local franchisee would have a "producer-assigned territory covering the geographical location of the buyer" and that such franchising rights would be part of the decision process when Scroggie selects the closest retailer to the buyer. One would have been motivated to select the proper franchisee in view of Stewart's discussion on the buyer selecting a preferred chain store.

Claims 5/2, 5/3, 25/14, 25/15, and 57: Scroggie and Stewart disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, 15, and 56 above, and Scroggie further discloses that the computer network is the Internet (col 1, line 31-40).

Claims 6/2, 6/3/ 26/14, 26/15, and 58: Scroggie and Stewart disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, 15, and 56 above, and Scroggie further discloses that the discount is a cash discount with an expiration date (col 10, lines 32-49).

Art Unit: 3622

Claims 7/2, 7/3, 8/2, 8/3, 17/14, 17/15, 19/14, 19/15, and 60: Scroggie and Stewart disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, 15, and 56 above, and Scroggie further discloses that the reseller and discount information is transmitted to the buyer via email (col 12, lines 44-53 and col 13, lines 21-34) or displayed on a website (col 11, lines 48-51 and col 12, lines 44-53).

Claims 9/2, 9/3, 10/2, 10/3, 11/10/2, 11/10/3, 18/14, 18/15, 29/14, 29/15, and 61: Scroggie and Stewart disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, 15, and 56 above, and Scroggie further discloses selecting the reseller geographically closest to the buyer, based on the buyer's zip code and email address provided as buyer information (col 6, lines 32-35 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3).

Claims 20/14 and 20/15: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claims 14 and 15 above, and Scroggie further discloses sending the buyer information and the discount to the reseller (col 2, lines 63-67).

Claim 32: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network, comprising:

- a. Advertising a plurality of discounts available for a plurality of products (col 13, lines 47-47);
- b. Receiving a product selection and buyer information from a buyer (col 1, lines 53-55; col 2, lines 11-19; and col 6, lines 12-15, 32-35, and 55-58);

Art Unit: 3622

c. Selecting a reseller and discount based on the selected product and buyer information (col 9, line 66 - col 10, line 3); and

d. Transmitting the reseller and discount information to the buyer (col 2, lines 1-4).

While Scroggie discloses selecting a retailer based on the location of the retailer in relation to the buyer, it is not explicitly disclosed that the retailer is selected based on the product and buyer information (other than buyer location). However, Stewart discloses a similar system and method for providing purchase information to a buyer over a computer network, which further discloses selecting a retailer based on the product (i.e. hotel room, rental car, etc.) and on the buyer's location, preferences, and demographics (i.e. preferred hotel company, room type, etc.)(col 22, lines 22-65). Stewart further discusses that the system attempts to locate a preferred retailer, but if one is not within an appropriate range (i.e. within walking distance if used in a shopping mall or airport), the system will select a similar retailer. For example, if Stewart receives a request from a buyer to find a restaurant offering a particular style of food (i.e. barbecue), the system will select an appropriate restaurant or if "not available in the immediate vicinity, the location service provider may suggest alternatives based on the known geographical location which most closely match the user's preferences" (col 26, lines 2-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such information as the desired product and the buyer's preferences when Scroggie selects the retailer. One would have been motivated to select the retailer based on the product and other

Art Unit: 3622

buyer information in order to ensure that the selected retailer carries the desired product and to better meet the desires of the buyer by limiting the selection to the nearest preferred retailer.

Claim 33: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, and Scroggie further discloses the incentive is a cash discount with an expiration date (col 10, lines 32-49).

Claim 35: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, and Scroggie further discloses transmitting the reseller and discount information to the buyer using the postal system (col 10, line 17).

Claim 37: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, and Scroggie further discloses selecting the reseller that is geographically closest to the buyer, based on the buyer's zip code and email address provided as buyer information (col 6, lines 32-35 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3).

Claims 38 and 39: Scroggie discloses a method for providing a purchase incentive to a buyer over a computer network, comprising:

- a. Receiving buyer information (col 1, lines 53-55 and col 6, lines 32-35 and 55-58);
- b. Determining the reseller covering the geographic area of the buyer (col 6, lines 32-55 and 55-58; col 8, lines 45-52; and col 9, line 66 - col 10, line 3); and

Art Unit: 3622

c. Transmitting the purchase incentive to the buyer, the purchase incentive being redeemable only at the selected reseller (col 1, lines 47-49; col 2, lines 1-4; and col 10, lines 26-27).

While Scroggie discloses determining the closest retailer to the buyer (within the geographic area of the buyer), it is not explicitly disclosed that the retailer has been assigned a predetermined area of coverage (i.e. has franchise rights) which includes the area in which the buyer is located. Stewart discloses a similar system and method for providing purchase information to a buyer and further discloses that the buyer can enter a preferred retailer/chain store (e.g. Denny's restaurant, Avis car rental, etc.). The system will attempt to locate the nearest Denny's restaurant or Avis car rental facility, if one is located within a reasonable distance from the buyer's location. Thus, the system is searching for the closest franchise to the buyer's location. It is inherent that a franchise has an assigned territory, as per the definition in Webster's II New Riverside University Dictionary, page 503, "**franchise**. 2. Authorization granted by a manufacturer to a distributor or dealer to sell its products. 3. The territory or limits within which a privilege, right, or immunity may be exercised". Thus, since Stewart allows the buyer to designate a preferred franchise (chain store), it would have been obvious to one having ordinary skill in the art at the time the invention was made that the local franchisee would have a "producer-assigned territory covering the geographical location of the buyer" and that such franchising rights would be part of the decision process when Scroggie selects the closest retailer

Art Unit: 3622

to the buyer. One would have been motivated to select the proper franchisee in view of Stewart's discussion on the buyer selecting a preferred chain store.

Claim 40: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 38 above, and Scroggie further discloses printing and redeeming the incentive (electronic voucher) at the reseller (col 1, line 62 - col 2, line 1 and col 12, lines 51-53).

Claim 41: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 40 above, and Scroggie further discloses the incentive is a cash discount with an expiration date (col 10, lines 32-49).

Claim 42: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 38 above, and Scroggie further discloses the buyer information including a zip code and email address (col 6, lines 32-35 and 55-58).

Claim 43: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 38 above, and Scroggie further discloses that the discount information is transmitted to the buyer via email (col 12, lines 44-53 and col 13, lines 21-34).

Claims 46 and 55: Scroggie and Stewart disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claim 44 and 53 above, and Scroggie further discloses receiving a producer (manufacturer) selection from the buyer and selecting the discount based on the selected producer (col 2, lines 45-51).

Art Unit: 3622

Claim 59: Scroggie and Stewart disclose a system for providing a purchase incentive to a buyer over a computer network as in Claim 56 above. Scroggie further discloses the incentive is redeemable only at the selected reseller (col 1, lines 47-49 and col 10, lines 26-27).

4. Claims 4, 5/4, 6/4, 7/4, 8/4, 9/4, 10/4, 11/10/4, 12, 16, 17/16, 18/16, 19/16, 20/16, 21, 24, 25/16, 25/24, 26/16, 26/24, 27, 28, 29/16, 29/24, 30, 31, 34, 36, 47-49, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al (6,185,541) in view of Stewart et al (6,259,405) and in further view of Cupps et al (5,991,739).

Claims 4, 12, 16, 21, 24, and 47: Scroggie and Stewart disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2, 3, 14, and 15 above, but neither reference explicitly discloses accessing a producer (manufacturer) database, displaying a list of producers to the buyer, and receiving the buyer's selection of a producer prior to accessing and displaying the list of products. However, Cupps discloses a similar system and method for providing a purchase incentive to a buyer over a computer network in which a manufacturer database is accessed, a list of manufacturers is displayed to the buyer, and the buyer selects a manufacturer (col 9, line 66 - col 10, line 21) prior to accessing and displaying the products available from that merchant. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allowing buyer to select a manufacturer prior to selecting a product. One would have been motivated to allow the buyer to

Art Unit: 3622

select the manufacturer in order to better meets the desires of the buyer, especially when “name-brand” items are desired (such as in clothing, watches, automobiles, etc.).

Claims 5/4, 25/16, and 25/24: Scroggie, Stewart, and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 4, 16, and 24 above. Each reference further discloses that the computer network is the Internet (Scroggie, col 1, line 31-40)(Stewart, col 6, lines 25-29)(Cupps, col 9, lines 37-39).

Claims 6/4, 26/16, and 26/24: Scroggie, Stewart, and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 4, 16, and 24 above. Scroggie further discloses that the discount is a cash discount with an expiration date (col 10, lines 32-49).

Claims 7/4, 8/4, 17/16, 19/16, 27, 28, and 52: Scroggie, Stewart, and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 4, 16, 24, and 47 above. Scroggie also discloses that the reseller and discount information is transmitted to the buyer via email (col 12, lines 44-53 and col 13, lines 21-34) or displayed on a website (col 11, lines 48-51 and col 12, lines 44-53).

Claims 9/4, 10/4, 11/10/4, 18/16, 29/16, 29/24, and 51: Scroggie, Stewart, and Cupps disclose a system and method for providing a purchase incentive to a buyer over a computer network as in Claims 2-4, 14-16, 24, and 47 above. All three references further disclose selecting the reseller geographically closest to the buyer, based on the buyer’s zip code and email address provided as buyer information (Scroggie, col 6, lines 32-35 and 55-58; col 8, lines 45-52; and col

Art Unit: 3622

9, line 66 - col 10, line 3)(Stewart, col 11, lines 21-31 and col 22, lines 49-53)(Cupps, col 9, line 66 - col 10, line 21 and Figure 3B, items 150 and 152).

Claim 20/16: Scroggie, Stewart, and Cupps disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 16 above. Scroggie further discloses sending the buyer information and the discount to the reseller (col 2, lines 63-67).

Claims 30 and 49: Scroggie, Stewart, and Cupps disclose a method for providing a purchase incentive to a buyer over a computer network as in Claims 24 and 47 above. Scroggie further discloses printing and redeeming the incentive (electronic voucher) at the reseller (col 1, line 62 - col 2, line 1 and col 12, lines 51-53).

Claim 31: Scroggie, Stewart, and Cupps disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 24 above. Scroggie further discloses presenting the buyer information to the reseller and receiving the discount (col 3, lines 1-6),

Claims 34 and 36: Scroggie and Stewart disclose a method for providing a purchase incentive to a buyer over a computer network as in Claim 32 above, but Scroggie does not explicitly disclose transmitting the reseller and discount information to the buyer via a telephone or fax machine. However, Stewart and Cupps disclose similar methods for providing a purchase incentive to a buyer over a computer network, and further disclose that the information could be transmitted to the buyer over the telephone or a fax machine (Stewart, col 19, lines 9-13)(Cupps, col 11, lines 24-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit the information to the buyer in Scroggie using a

Art Unit: 3622

telephone or fax machine. One would have been motivated to use one of these devices in order to use a more secure means of communicating the information.

Claim 48: Scroggie, Stewart, and Cupps disclose a system for providing a purchase incentive to a buyer over a computer network as in Claim 47 above. Scroggie further discloses the incentive is redeemable only at the selected reseller (col 1, lines 47-49 and col 10, lines 26-27).

Response to Arguments

5. Applicant's arguments with respect to the Awada reference have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Ross et al (5,943,653) discloses a system and method for providing purchase incentives (coupons) to users based on their location and a selected product/service. When the selected service is a national chain (franchise) the coupon may be applicable nationwide or only to a particular store.

Art Unit: 3622

B. Walker et al (6,249,772) discloses a system and method for selecting a local retailer based on the user's location (zip code or telephone number) and product selection and to purchase the item at the local franchise at a price set by the manufacturer.

C. O'Connor et al (US2001/0011225) discloses a system and method for making appointments online based on the product/service selected by the user and the location (zip code) of the user.

D. Rhoads (US2001/0023193) discloses a system and method for a user to scan in a product code (from a newspaper, catalog, etc.) and to select the closest retailer (franchise such as Dominos Pizza) based on the user's GPS-equipped cellular phone.

E. Noll et al (US2002/0022970) discloses a system and method for a user to select a desired brand of products and to select and display the local retail outfit of the brand's manufacturer (i.e. franchise) who is responsible to fulfill the offer (coupon).

F. Barnett et al (WO 99/52055) discloses a system and method for providing a discount incentive to a user based on user information and location.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

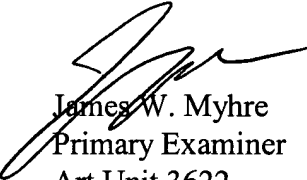
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal

Art Unit: 3622

or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
July 25, 2003


James W. Myhre
Primary Examiner
Art Unit 3622